

DOCKET NO.: 65380-004



#17
8/13/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Ronald J. MacNeil

Group No.: 3711

Serial No.: 09/030,702

Examiner: W. Grieb

For: LACROSSE STICK HEAD

DECLARATION OF MARK FORD

Mark Ford hereby declares as follows:

1. I am an officer and principal of Shamrock Lacrosse, Inc., assignee of the present application.

2. This declaration is submitted in response to the Office Action of January 19, 2000 wherein the Examiner relied upon the letter of Ronald J. MacNeil asserting that the pending offset feature was prior art.

3. I first met inventor Ronald J. MacNeil on or about Friday, January 29, 1995 at the Men's Lacrosse Coaches Convention held at the Glenpointe Marriot in Teaneck, New Jersey. Mr. MacNeil was a vendor at the convention and showed me the original box lacrosse version of the then patent pending Lacrosse stick, which included the wings and the offset feature. Mr. MacNeil explained that he designed the stick so the mouth and sidewall were below the shaft in order to increase velocity, centrifugal force, and leverage when shooting, cradling and passing. He stated that if his then pending patent for the stick was granted it would be the most revolutionary design change in the history of Lacrosse.

4. Mr. MacNeil gave me a sample box lacrosse stick to show to my lacrosse players at Roger Williams University where I was the Head Coach. Mr. MacNeil explained to me that he made the lacrosse sticks in Canada and that he needed a potential sales rep for the United States. During the spring of 1995, I contacted Mr. MacNeil about being a sales rep for the United States and he agreed and we continued to talk throughout the spring and summer about the production of field lacrosse products that would be marketable in the United States.

5. In the fall of 1995, Mr. MacNeil reported to me that he and his partner were dissolving their relationship and he offered to start a new corporation with myself.

We agreed that if I would put up production capital he would assign the soon to be allowed patent to the corporation. Again Mr. MacNeil spoke about the incredible value of the offset design.

6. Mr. MacNeil and I continued to speak weekly throughout the fall of 1995, and I reported that a friend of mine from high school, Mr. Peter Rogers, was also interested in being a partner. Mr. MacNeil mentioned that he was working on a prototype model of a field version of the lacrosse head and we met one evening in November, 1995 in Northern New Jersey.

7. Peter Rogers and I drove to Canada to meet with Mr. MacNeil and his family on Sunday, December 10, 1995 to discuss the proposal for starting a lacrosse manufacturing business. Peter Rogers and I proposed a 50/25/25 shares split for a company which became assignee, Shamrock Lacrosse, Inc., and which was incorporated in the state of New Jersey. Peter Rogers and I would agree to invest \$30,000.00 Canadian dollars each and Mr. MacNeil would assign the pending patent to the company. It was at this meeting that Mr. MacNeil boasted of the fact that the value of his recently allowed patent was much greater than \$60,000.00 Canadian dollars because of the offset design concept.

8. Mr. MacNeil convinced us that he was the first to have the offset concept and explained that he was the first to file any lacrosse head patent that depicted the offset. Mr. MacNeil's conviction about the offset was the most important factor in our decision to invest our capital with him. We all agreed to proceed and we retained an attorney to form a corporation and draw up a shareholders agreement with the inventor assigning the patent to the corporation.

9. Mr. MacNeil then came down to the Untied States on a weekend near the end of January 1996 to sign corporate documents and discuss plans to make a mold for our prototype in Canada. At this meeting we gave Mr. MacNeil money to move forward, with manufacturing being Mr. MacNeil's primary responsibility.

10. Over the next year, the mold could not get finished. Mr. MacNeil had problems with E. Hoffman Plastics, the company contracted to construct the mold. Mr. Rogers and I were forced to travel to Canada to resolve the differences between Mr. MacNeil and E. Hoffman Plastics in the fall of 1996.

11. We had a meeting with the owners of E. Hoffman Plastics and resolved all problems with them by agreeing to pay a reduced amount for the mold in order to get possession of our property. Mr. MacNeil, however, thought that it was in his interest to not allow us to take the mold from E. Hoffman Plastics when we went to his house less than an hour later and told him of our successful compromise plan. Instead, he demanded to be bought out for \$20,000.00 revenue from the company and we returned to the Untied States without completing the plan for the mold.

12. After talking to our attorney and Mr. MacNeil's Canadian attorney, Mr. MacNeil increased his buy out figure to U.S. \$30,000.00 and a split of other stringing materials and inventory for which we had already paid. Throughout the process Mr. MacNeil always contended that the value of the offset design depicted in the figure of his patent would be more valuable to us than any price we paid to him for the rights of the patent. He also indicated that if we bought him out that all patent rights would be completely ours regarding the "offset".

13. After successfully meeting Mr. MacNeil's demands we completed the necessary tooling on the lacrosse had mold in order to make good plastic parts and soon after. On February 27, 1996, we were awarded the patent from the United States Patent and Trademark Office. Sometime thereafter, we realized that the patent did not contain the feature as represented to us.

14. Although we concentrated on the production of the lacrosse products we contacted Scott Fields in early 1998 to investigate the procedures for filing for the reissue of our patent to claim the offset design when we learned that the patent did not.

15. Mr. Scott Fields, our attorney, sent a letter to Mr. MacNeil indicating our plans to file a reissue. Two days later Mr. MacNeil called Peter Rogers at his home and spoke to Mr. Rogers' wife asking that Mr. Rogers call him in Canada. Mr. MacNeil insinuated that his cooperation "would have a price".

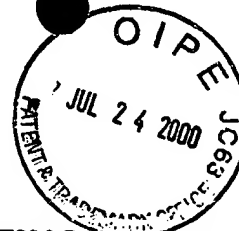
16. As per the advice of Scott Fields, Peter did not call Mr. MacNeil back and shortly thereafter Scott received the letter from Mr. MacNeil stating that he never claimed the offset because of prior art. The letter was clearly sent because we refused to pay additional monies to Mr. MacNeil.

17. Mr. MacNeil was clearly looking for a payment to cooperate with the reissue proceeding.

I hereby declare that the foregoing is true and correct under penalty of perjury.

Date: _____

MARK FORD

**DOCKET NO.: 85380-004****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of

Ronald J. MacNeil

Group No.: 3711

Serial No.: 08/030,702

Examiner: W. Grieb

For: **LACROSSE STICK HEAD****DECLARATION OF PETER ROGERS**

Peter Rogers hereby declares as follows:

1. I am an officer and principal of Shamrock Lacrosse, Inc., assignee of the patent application.

2. This declaration is submitted in response to the Office Action of January 18, 2000 wherein the Examiner relied upon the letter of Ronald J. MacNeil asserting that the pending offset feature was prior art.

3. Mark Ford and I met with Mr. MacNeil and his family on Sunday, December 10, 1995 to discuss the proposal for starting a lacrosse manufacturing business. We proposed a 50/25/25 shares split for a company which became assignee, Shamrock Lacrosse, Inc., and which was incorporated in the state of New Jersey. Mark Ford and I would agree to invest \$30,000.00 Canadian dollars each and Mr. MacNeil would assign the pending patent to the company. It was at this meeting that Mr. MacNeil boasted of the fact that the value of his recently allowed patent was much greater than \$80,000.00 Canadian dollars because of the offset design concept.

4. Mr. MacNeil convinced us that he was the first to have the offset concept and explained that he was the first to file any lacrosse head patent that depicted the offset. Mr. MacNeil's conviction about the offset was the most important factor in our decision to invest our capital with him.

5. Mr. MacNeil then came down to the United States on a weekend near the end of January 1996 to sign corporate documents and discuss plans to make a mold for our prototype in Canada. At this meeting we gave Mr. MacNeil money to move forward, with manufacturing being Mr. MacNeil's primary responsibility.

Over the next year, the mold could not get finished. We were unable to work with Mr. MacNeil and he requested to be bought out.

After talking to our attorney and Mr. MacNeil's Canadian attorney, Mr. MacNeil increased his buy out figure to U.S. \$30,000.00 and a split of other stringing materials and inventory for which we had already paid. Throughout the process Mr. MacNeil always contended that the value of the offset design depicted in the figure of his patent would be more valuable to us than any price we paid to him for the rights of the patent. He also indicated that if we bought him out that all patent rights would be completely ours regarding the "offset".

After successfully meeting Mr. MacNeil's demands we completed the necessary tooling on the lacrosse lead mold in order to make good plastic parts and earn a profit. On February 27, 1996, we were awarded the patent from the United States Patent and Trademark Office. Sometime thereafter, we realized that the patent did not contain the feature as represented to us.

Although we concentrated on the production of the lacrosse products we contacted Scott Fields in early 1998 to investigate the procedures for filing for the reissue of our patent to claim the offset design when we learned that the patent did not

Mr. Scott Fields, our attorney, sent a letter to Mr. MacNeil indicating our plans to file a reissue. Two days later Mr. MacNeil called me at his home and spoke to my wife asking that I call him in Canada. Mr. MacNeil insinuated that his cooperation "would have a price".

As per the advice of Scott Fields, I did not call Mr. MacNeil back and shortly thereafter Scott received the letter from Mr. MacNeil stating that he never claimed the offset because of prior art. The letter was clearly sent because we refused to pay additional monies to Mr. MacNeil.

Mr. MacNeil was clearly looking for a payment to cooperate with the reissue proceeding.

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Date:

July 17, 2000


PETER ROGERS



DOCKET NO. 65380-004

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In re patent application of

Ronald J. MacNeil

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Serial No.: 09/030,702

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5. Mr. Scott Fields, our attorney, sent a letter to Mr. MacNeil indicating our plans to file a reissue. Two days later Mr. MacNeil called Peter Rogers at his home and spoke to Mr. Rogers' wife asking that Mr. Rogers call him in Canada. Mr. MacNeil intimated that his cooperation "would have a price".

6. As per the advice of Scott Fields, Peter did not call Mr. MacNeil back and shortly thereafter Scott received the letter from Mr. MacNeil stating that he never claimed the offset because of prior art. The letter was clearly sent because we refused to pay additional monies to Mr. MacNeil.

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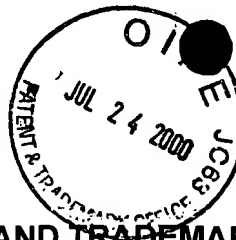
I hereby declare that the foregoing is true and correct under penalty of perjury.

Date:

7-18-00


MARK FORD

DOCKET NO.: 65380-004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Ronald J. MacNeil

Group No.: 3711

Serial No.: 09/030,702

Examiner: W. Grieb

For: **LACROSSE STICK HEAD**

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12. Mr. MacNeil was clearly looking for a payment to cooperate with the reissue proceeding.

I hereby declare that the foregoing is true and correct under penalty of perjury.

Date: _____

PETER ROGERS

DOCKET NO.: 65380-004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Ronald J. MacNeil

Serial No.: 09/030,702



Group No. 3711

Examiner: M. Chambers

DECLARATION OF SCOTT J. FIELDS

Scott J. Fields hereby declares under penalty of perjury as follows:

1. I am the attorney of record in the above-captioned matter.
2. Beginning about December, 1997 to January 1998, during the preparation of the reissue application in the above-captioned matter, I contacted inventor Ronald J. MacNeil for the purpose of soliciting his cooperation in support of broadened claims.
3. Mr. MacNeil initially indicated a willingness to provide such cooperation.
4. Shortly thereafter, in following up, I was informed by Mr. MacNeil that his cooperation in support of the reissue application would require an additional payment of funds.
5. When I explicitly informed Mr. MacNeil that my client would refuse to pay him in consideration for his contractually required cooperation, he informed me of "alleged" prior art from Canada and sent me the letter which has been provided to The Patent and Trademark Office.
6. Mr. MacNeil has never provided me with any information in support of his allegations.
7. It is clear that Mr. MacNeil's current position is solely an act of retribution for our client's failure to pay him additional unwarranted funds.

Date: 7-19-00

SCOTT J. FIELDS, ESQUIRE